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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,009	10/02/2003	Mitchell Schlansky	2195.0010000	6426
26111	7590	06/19/2006	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER

3728

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,009

Applicant(s)

SCHLANSKY, MITCHELL

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action acknowledges the applicant's amendment submitted 29 March 2006. Claims 1-10 and 12-27 are pending in the application. Claim 11 has been canceled. Claims 24-27 are new to the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings are objected to under 37 CFR 1.84(b). Photographs, including photocopies of photographs, are not ordinarily permitted in utility and design patent applications (see Figures 6-10). The subject matter of this application admits of illustration by a drawing. Therefore, drawings in place of the photographs are required. No new matter should be entered.

Claim Rejections - 35 USC § 103

4. Claims 1-4, 8, 18-20, 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman et al (US 2,809,004; hereinafter Kaufman).

Claims 1, 18, 23, 24, 26, and 27: Kaufman discloses an article **28** with a base **11**, a first and second arm **20** biased as claimed, and a fastener **12** functioning as a means for removably securing article **28** to a surface **10**. The distal ends of arms **20** of

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Kaufman provide first outward curves and first inward curves as claimed. Connection points **14** and **16** are not movable relative to one another.

Kaufman does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the arms of Kaufman with outwardly curving flanges with a distal end in close proximity to the first inward curve because applicant has not disclosed that the outwardly curving flanges as claimed provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with or without the outwardly curving flanges because the inward curve is the portion effective in providing the spreading and resilient retention of the device within the article.

Therefore, it would have been an obvious matter of design choice to modify the arms of Kaufman to obtain the invention as specified.

Claims 2 and 19: Kaufman discloses the claimed S-Shape.

Claim 3: Kaufman discloses fastener **12** removably securing the article **28** to surface **10**.

Claims 4 and 20: Kaufman discloses article **28** as made from a single unit of material.

Claim 8: Insofar as the device is not positively claimed, Kaufman is fully capable of holding an electronic device.

5. Claims 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor (US 5,678,204).

Naylor discloses an article **10** (see Figures 1-6) comprising a base **14**, a first arm **20**, and second arm **22** biased as claimed. Article **10** of Naylor is fully capable of receiving and retaining a device as claimed.

Naylor does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the arms of Naylor with outwardly curving flanges with a distal end in close proximity to the first inward curve because applicant has not disclosed that the outwardly curving flanges as claimed provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with or without the outwardly curving flanges because the inward curve is the portion effective in providing the spreading and resilient retention of the device within the article.

Therefore, it would have been an obvious matter of design choice to modify the arms of Naylor to obtain the invention as specified.

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6. Claims 5-7, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman as applied to claims 1 and 18 above, and further in view of Trumbull (US 4,991,801).

Kaufman discloses the claimed invention except for the coating.

Trumbull teaches coating a holding article for electrical insulation (Col. 3, lines 8-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman with a coating as taught by Trumbull in order to electrically insulate the article. Such a coating provides both a friction-increasing surface and a scratch-resistant substance.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman as applied to claim 1 above, and further in view of Krillenberger (US 5,307,543).

Kaufman discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the area around aperture **18** against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman with ribs as taught by Krillenberger in order to stiffen the areas around the fasteners.

8. Claims 10, 12, 13, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (US 4,306,737) in view of Genzel (US 5,140,723).

Claims 10 and 25: Errichiello discloses a notebook **10** with an article (clip formed by **52/54**) for holding a device having a first arm **52** and second arm **54** biased toward each other. Errichiello merely lacks the express disclosure of a base.

Genzel teaches a separable base **10** with attached arms **12** for separation of the clip and attachment to an article of clothing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the clips of Errichiello on a separable base as taught by Genzel in order to enable the removal of the clips with subsequent attachment to an article of clothing. Both Errichiello and Genzel disclose clips with arms connected to the base at points that are not movable relative to one another and it would have been obvious to retain this feature in the combination in order to retain the resilient clamping feature of the clips.

Errichiello-Genzel does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the arms of Errichiello-Genzel with outwardly curving flanges with a distal end in close proximity to the first inward curve because applicant has not disclosed that the outwardly curving flanges as claimed provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with or without the outwardly curving flanges because the inward curve is the portion effective in providing the spreading and resilient retention of the device within the article.

Therefore, it would have been an obvious matter of design choice to modify the arms of Errichiello-Genzel to obtain the invention as specified.

Claim 12: Errichiello-Genzel discloses the claimed curved S-like shape.

Claim 13: Although Genzel discloses various materials for the base and arms, the reference anticipates each component made of plastic material, in which case it would have been obvious to integrally mold the holder from a single unit of material.

Claim 16: The device is not positively claimed. Errichiello-Genzel is capable of retaining an unspecified electronic device (for example, a pen-shaped, laser pointer device).

9. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel as applied to claim 10 above, and further in view of Corey (US 5,059,051).

Errichiello-Genzel merely lacks the coating. Corey teaches a coating **35** over retaining arms **12** for the purpose of damage prevention for the retained objects. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the arms of Errichiello-Genzel with a coating as taught by Corey in order to limit damage potential to retained objects.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel as applied to claim 10 above, and further in view of Krillenberger.

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Errichiello-Genzel discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the base against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Errichiello-Genzel with ribs as taught by Krillenberger in order to stiffen the base against bending.

11. Claims 1-4, 8, 18-20, 23, 24, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman in view of Cohen (US 5,549,406).

Claims 1, 18, 23, 24, 26, and 27: Kaufman discloses an article **28** with a base **11**, a first and second arm **20** biased as claimed, and a fastener **12** functioning as a means for removably securing article **28** to a surface **10**. The distal ends of arms **20** of Kaufman provide first outward curves and first inward curves as claimed. Connection points **14** and **16** are not movable relative to one another.

Kaufman does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

Kaufman discloses the claimed invention except that Kaufman uses a blunt end at the distal portion of the arms instead of an outwardly curving flange with a distal end in close proximity to the first inward curve. Cohen shows that an outwardly curving flange with a distal end in close proximity to the first inward curve was an equivalent structure known in the art. In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re*

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Ruff, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Cohen represents evidence that an outwardly curving flange with a distal end in close proximity to the first inward curve and a blunt end were art-recognized equivalent structures for terminating portions of spring arms (see Cohen, Col. 2, lines 42-46). Therefore, because these two terminating means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute an outwardly curving flange with a distal end in close proximity to the first inward curve for the blunt ends of Kaufman. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claims 2 and 19: Kaufman-Cohen discloses the claimed S-Shape.

Claim 3: Kaufman discloses fastener **12** removably securing the article **28** to surface **10**.

Claims 4 and 20: Kaufman discloses article **28** as made from a single unit of material.

Claim 8: Insofar as the device is not positively claimed, Kaufman-Cohen is fully capable of holding an electronic device.

12. Claims 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor in view of Cohen.

Naylor discloses an article **10** (see Figures 1-6) comprising a base **14**, a first arm **20**, and second arm **22** biased as claimed. Article **10** of Naylor is fully capable of receiving and retaining a device as claimed.

Naylor does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

Naylor discloses the claimed invention except that Naylor uses a blunt end at the distal portion of the arms instead of an outwardly curving flange with a distal end in close proximity to the first inward curve. Cohen shows that an outwardly curving flange with a distal end in close proximity to the first inward curve was an equivalent structure known in the art. In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Cohen represents evidence that an outwardly curving flange with a distal end in close proximity to the first inward curve and a blunt end were art-recognized equivalent structures for terminating portions of spring arms (see Cohen, Col. 2, lines 42-46). Therefore, because these two terminating means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute an outwardly curving flange with a distal end in close proximity to the first inward curve for the blunt ends of Naylor. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

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13. Claims 5-7, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman-Cohen as applied to claims 1 and 18 above, and further in view of Trumbull.

Kaufman-Cohen discloses the claimed invention except for the coating.

Trumbull teaches coating a holding article for electrical insulation (Col. 3, lines 8-10). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman-Cohen with a coating as taught by Trumbull in order to electrically insulate the article. Such a coating provides both a friction-increasing surface and a scratch-resistant substance.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufman-Cohen as applied to claim 1 above, and further in view of Krillenberger.

Kaufman-Cohen discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the area around aperture **18** against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Kaufman-Cohen with ribs as taught by Krillenberger in order to stiffen the areas around the fasteners.

15. Claims 10, 12, 13, 16, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello in view of Genzel and Cohen.

Claims 10 and 25: Errichiello discloses a notebook **10** with an article (clip formed by **52/54**) for holding a device having a first arm **52** and second arm **54** biased toward each other. Errichiello merely lacks the express disclosure of a base.

Genzel teaches a separable base **10** with attached arms **12** for separation of the clip and attachment to an article of clothing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the clips of Errichiello on a separable base as taught by Genzel in order to enable the removal of the clips with subsequent attachment to an article of clothing. Both Errichiello and Genzel disclose clips with arms connected to the base at points that are not movable relative to one another and it would have been obvious to retain this feature in the combination in order to retain the resilient clamping feature of the clips.

Errichiello-Genzel does not expressly disclose an outwardly curving flange with a distal end in close proximity to the first inward curve.

Errichiello-Genzel discloses the claimed invention except that Errichiello-Genzel uses a blunt end at the distal portion of the arms instead of an outwardly curving flange with a distal end in close proximity to the first inward curve. Cohen shows that an outwardly curving flange with a distal end in close proximity to the first inward curve was an equivalent structure known in the art. In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Cohen represents evidence that an outwardly curving flange with a distal end in close proximity to the first inward curve and a blunt end were art-recognized equivalent structures for terminating

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portions of spring arms (see Cohen, Col. 2, lines 42-46). Therefore, because these two terminating means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute an outwardly curving flange with a distal end in close proximity to the first inward curve for the blunt ends of Errichiello-Genzel. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claim 12: Errichiello-Genzel-Cohen discloses the claimed curved S-like shape.

Claim 13: Although Genzel discloses various materials for the base and arms, the reference anticipates each component made of plastic material, in which case it would have been obvious to integrally mold the holder from a single unit of material.

Claim 16: The device is not positively claimed. Errichiello-Genzel-Cohen is capable of retaining an unspecified electronic device (for example, a pen-shaped, laser pointer device).

16. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel-Cohen as applied to claim 10 above, and further in view of Corey.

Errichiello-Genzel-Cohen merely lacks the coating. Corey teaches a coating **35** over retaining arms **12** for the purpose of damage prevention for the retained objects. It would have been obvious to one of ordinary skill in the art at the time the invention was

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made to provide the arms of Errichiello-Genzel-Cohen with a coating as taught by Corey in order to limit damage potential to retained objects.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello-Genzel-Cohen as applied to claim 10 above, and further in view of Krillenberger.

Errichiello-Genzel-Cohen discloses the claimed invention except for the reinforcement ribs.

Krillenberger teaches reinforcement ribs **20 & 22** used to stiffen the base against bending (Col. 2, lines 30-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Errichiello-Genzel-Cohen with ribs as taught by Krillenberger in order to stiffen the base against bending.

Response to Arguments

18. Applicant's arguments filed 29 March 2006 have been fully considered but they are not persuasive.

Since the examiner has reconsidered the utility of the distal portions of the arms and taken a position contrary to that presented to the applicant in the interview of 18 January 2006, this action is made **NON-FINAL**.

A careful reading of the applicant's specification finds no mention that the outwardly curving flange with a distal end in close proximity to the first inward curve provides an advantage, is used for a particular purpose, or solves a stated problem. As

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such, the feature appears to be an obvious matter of design choice based on aesthetics.

Moreover, Cohen represents evidence that an outwardly curving flange with a distal end in close proximity to the first inward curve and a blunt end were art-recognized equivalent structures known in the art at the time the invention was made, and that the two features were interchangeable (Cohen Col. 2, lines 42-46).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Greg Pickett
Examiner
6 June 2006


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